

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

TAKETOMI, SUSAMU et al.

Serial No.: 09/679,856

Filed: October 5, 2000

GLASS COMPOSITE INCLUDING
DISPERSED RARE EARTH IRON
GARNET NANOPARTICLES

Docket No.: 30812

Group Art Unit No.: 1773

Examiner:

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

VERIFIED STATEMENT
UNDER 37 C.F.R. § 5.25(a)(3)

I, KENNETH J. KLABUNDE, do declare and state that:

1. I am one of the inventors of the subject matter described and claimed in the above-identified patent application. This subject matter was developed both in Japan and the United States.
2. I have been advised that at least some of the subject matter of the above-identified U.S. patent application is contained in an application for Letters Patent filed in the Japanese Patent Office on April 5, 2000 and accorded Application No. 2000-140930.
3. The Japanese patent application was filed under the direction of one of the co-inventors of the U.S. patent application, namely Susamu Taketomi, and was done without my knowledge, although I was named an inventor. I did not learn of the Japanese filing until some time in early September, 2000, although I was aware of a prior Japanese newspaper publication disclosing certain aspects of the invention, published in Japan on October 6, 1999.

Specifically, I, along with the other two inventors, submitted a disclosure to the Kansas State University Research Foundation ("Foundation") on or about September 13, 2000.

4. On or about September 22, 2000, a meeting was held at the Foundation to determine whether a U.S. patent application should be filed. All three inventors were present at that meeting, along with Messrs. Ron Trewyn, Gary Rabold and Ron Sampson. Mr. Trewyn is the President of the Foundation, Mr. Rabold is Vice President of Mid-America Commercialization Corporation ("MACC") and Mr. Sampson is President of MACC. MACC is an organization in Manhattan, KS which cooperates with the Foundation in commercialization of inventions. At the September 22, 2000, meeting, the participants were aware of the need to file the U.S. application prior to October 6, 2000, in order to avoid having the Japanese publication become prior art against the U.S. application. However, at the September 22, 2000, meeting, I was not aware of the potential foreign license problem presented by the earlier Japanese application, and to my knowledge none of the other participants understood this to be an issue.
5. At the conclusion of the September 22, 2000, meeting, it was decided to prepare and file a U.S. patent application. Upon information and belief, the Foundation retained patent counsel shortly after September 22, 2000. After such retention, work was immediately commenced on the U.S. patent application, which involved intensive efforts to complete the application for filing prior to October 6, 2000. As indicated, the U.S. application was actually filed on October 5, 2000. During the course of preparation of the U.S. application, I was for the first

time aware of the foreign license issue, but all of our efforts at that time were directed towards completing the application.

6. I have been advised by our patent counsel that the filing receipt for the U.S. application was received December 11, 2000. In addition, Dr. Taketomi has been traveling after the filing of the U.S. application, and he is not scheduled to return to Manhattan, KS until about December 21, 2000. Dr. Taketomi has virtually all of the knowledge of the facts surrounding the filing of the earlier Japanese application. Therefore, this license has been diligently sought under the facts of this case.
7. The subject matter of the Japanese application was not under a secrecy order at the time it was filed abroad (April 5, 2000), and the subject matter of the Japanese and U.S. applications is not currently under a secrecy order.
8. I further declare that all of my statements made herein are true and are made as a result of my own knowledge and experience, with the knowledge that willful false statements are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that any such willful false statements may jeopardize the validity of the above-referenced application or any patent issuing thereon.

Date:

February 3, 2001

Kenneth J. Klabunde
KENNETH J. KLABUNDE